REMARKS/ARGUMENTS

Claims 1, 4, 5, 14, 20, 24, 28, 37, 43 were amended. Claims 2-3, 6-13, 15-19, 21-23, 25-27, 29-36, 38-42, 44, 45 remain unchanged.
The claim amendments remove the objectionable language of "adapted to".

Independent claims 1 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gobburu et al (US 6,736,322), in view of Young et al (US Publication No: 2002/0065774) as set forth in the non-final office action of October 18, 2007 (non-final office action).

A. In the office action of October 18, 2007 (non-final office action), the Examiner admitted that "Gobburru does not specifically disclose the following limitations. Young, however, as shown discloses":

a merchant server adapted to receive a purchase order from said customer for the purchase of said digital good, and to create a digital order comprising purchase order information; (see at least Young paragraph 0008, 0009, 0018)

a payment server adapted to receive said digital order from said merchant server and to further route said digital order; (see at least Young paragraphs 0009, 0011, 0037, 0060)

an authentication server adapted to receive said digital order from said payment server, format said digital order into a first message and further route said first message; (see at least Young paragraphs 0008, 0060)

a communication device comprising a payment card module wherein said payment card module is adapted to receive a payment card and read payment card identification information stored in said payment card, and wherein said communication device is adapted to receive said first message from said authentication server, display said first message to said customer, request and receive authorization for payment for said purchase order with said payment card from said customer, retrieve said payment

card identification information, request and receive payment card security information from said customer, (see at least Young paragraphs 0039, 0057, 0060)

wherein said financial institution is asked to execute said payment and to send a payment confirmation through said payment server to said merchant server and to said authentication server; (see at least Young paragraphs 0021, 0040, 0057, 0060, 0062)
and

a fulfillment server adapted to receive said payment confirmation from said payment server and transmit said digital good via said authentication server to said communication device, wherein said communication device stores said digital good onto said payment card (see at least Young paragraph 0009, 0010, 0011).

Previously the Examiner stated that Gobburu discloses the limitation of:

"route said authorization and said payment card identification and security information to the authentication server, and wherein said authentication server further routes said authorization and payment card identification and security information to said payment server and from said payment server to a financial institution" (see at least Gobburu column 18, lines 43-50).

The Examiner further argued that it would have been obvious to combine the two cited documents to arrive to the present invention of claims 1 and 23.

In the response of January 8, 2008, Applicant agreed with the Examiner's statement regarding Gobburru et al that it does not teach the specific limitation of :
"a communication device comprising a payment card reader wherein said payment card reader receives a payment card and reads payment card identification information stored in said payment card "

Applicant then pointed out that actually Young et al do not teach the above mentioned limitation, either. As shown in FIG. 1 of Young et al, the electronic wallet 16 that comprises the payment card information is a separate component from the mobile phone 10 (see also paragraph [0037]). In other words, Young et al do not teach a mobile phone that includes a payment card reader.

Actually the mobile phone 10 is so far removed from the electronic wallet 16 that they communicate via the Internet (see paragraph [0037]). In other words, Young's mobile phone does not comprise a payment card reader that receives a payment card and reads the payment card identification information stored in the payment card.

Furthermore, Young et al teach away from such a configuration by saying that " The electronic wallet 16 comprises payment data related to the user 5 previously entered by the user. For example, the wallet contains a preferred method of payment comprising a credit card type, number, and expiration date" (0057). In other words, the payment information in the electronic wallet is not read from a payment card, but was previously entered by the user.

Due to the fact that neither Gobburru nor Young teach a mobile phone that comprises a payment card reader that receives a payment card and reads the payment card identification information stored in the payment card, it is concluded that their combination does not teach this specific limitation either and therefore claims 1 and 23 are patentably distinguishable from Gobburru or Young or their combination. Accordingly, it is concluded that a *prima facie* evidence of obviousness of claims 1 and 23 over Gobburu et al (US 6,736,322), in view of Young et al (US Publication No: 2002/0065774) was not provided.

In the final office action of April 29, 2008 (final office action), the Examiner states that "a communication device comprising a payment card module wherein said payment card

module is adapted to receive a payment card and read payment card identification information stored in said payment card" is disclosed by Gobburu, Young and Jacobson. Jacobson discloses the limitation in paragraphs 0020 and 0023.

However, this statement regarding the Gobburu reference contradicts the Examiner's statement in the non-final office action that Gobburu does not disclose "a communication device comprising a payment card module wherein said payment card module is adapted to receive a payment card and read payment card identification information stored in said payment card". Furthermore, the Examiner does not mention any specific reference in the Gobburu document where this specific limitation is disclosed.

The statement that Young teaches "a communication device comprising a payment card module wherein said payment card module is adapted to receive a payment card and read payment card identification information stored in said payment card" was addressed above.

Regarding the statement that "Jacobson discloses the limitation in paragraphs 0020 and 0023", applicant notes that paragraph 0020 refers to US Patent 5,748,737 issued to Dagger. However, Dagger's electronic wallet although it is adapted to read/write data on a smart card, it is not comprised within a mobile phone. Accordingly, even if one combined Gobburu et al (US 6,736,322), in view of Young et al (US Publication No: 2002/0065774) and further in view of Jacobson (i.e., Dagger), one would not arrive to the limitation of the present invention of having "a communication device comprising a payment card reader wherein said payment card reader is adapted to receive a payment card and read payment card identification information stored in said payment card".

Furthermore, paragraph 0023 of Jacobson states that "the payment device includes a mobile terminal and a financial storage element connected to the mobile terminal" However, the financial storage element is a magnetic stripe 112 (see paragraph 0103) and it is not "a communication device comprising a payment card module wherein said payment card module is adapted to receive a payment card and read payment card

identification information stored in said payment card". Again, even if one combined Gobburu et al (US 6,736,322), in view of Young et al (US Publication No: 2002/0065774) and further in view of Jacobson, one would not arrive to the limitation of the present invention of having "a communication device comprising a payment card reader wherein said payment card reader receives a payment card and reads payment card identification information stored in said payment card".

Furthermore, applicant needs to point out that claims 1 and 23 were not rejected in either the final or non-final office actions under 35 U.S.C. 103(a) as being unpatentable over Gobburu et al (US 6,736,322), in view of Young et al (US Publication No: 2002/0065774) and further in view of Jacobson.

Based on the above mentioned reasons, it is believed that any rejection of claims 1 and 23 over Gobburu et al (US 6,736,322), in view of Young et al (US Publication No: 2002/0065774) and further in view of Jacobson is overcome.

B. In the office action of October 18, 2007 (non-final office action), the Examiner admitted that "Gobburru does not specifically disclose the limitation of claims 1 and 23 of:
"a merchant server adapted to receive a purchase order from said customer for the purchase of said digital good, and to create a digital order comprising purchase order information"

The Examiner then argued that Young et al however, discloses the above mentioned limitation. See page 3 of the non-final office action. The Examiner further argued that it would have been obvious to combine the two cited documents to arrive to the present invention of claims 1 and 23.

Applicant responded that neither Young et al teach the above mentioned limitation because they do not refer to purchasing digital goods, such as electronic cash, electronic tickets, electronic coupons, loyalty points, credits for pre-paid mobile airtime, etc. On the contrary, Young et al teach buying physical goods online such as a coat viewed in a retail store (see paragraph [0048]).

Since neither Gobburru et al teach this limitation (as the Examiner admitted) and nor Young et al teach this exact limitation (as the Applicant pointed out), it is concluded that the combination of Gobburru and Young does not teach this limitation either.

In the present office action the Examiner states that Gobburru discloses the limitation of a digital good (column 20, lines 46-53). However, Gobburru et al disclose a cell phone that is specifically programmed to provide coupon storage. The stored coupon is redeemed at the time of completing the purchase by presenting a bar code 306 in the cell phone screen (shown in FIG. 3) which is then read by the merchant's bar code reader. Although Gobburru's stored coupon is a stored digital good, there is still no reason or motivation for combining the teachings of Gobburru (i.e., storing digital coupons in cell phones; see column 2, line 7) with the teachings of Young (i.e., selling physical goods to a customer after receiving orders via the customer's phone; see paragraphs [0048] and [0049]).

C. In the office action of October 18, 2007 (non-final office action), the Examiner admitted that "Gobburru does not specifically disclose the limitation of claims 1 and 23 of: "a fulfillment server adapted to receive said payment confirmation from said payment server and transmit said digital good via said authentication server to said communication device, wherein said communication device stores said digital good onto said payment card."

The Examiner then argued that Young et al however, discloses the above mentioned limitation. See page 3 of the first office action. The Examiner further argued that it would have been obvious to combine the two cited documents to arrive to the present invention of claims 1 and 23.

Applicant responded that neither Young et al teach the above mentioned limitation that " the "fulfillment server... transmits the digital good via the authentication server to the communication device" because a physical good, such as a coat cannot be transmitted via the authentication server to the communication device.

In the final office action the Examiner presents a new reference Kelly (US5,816,918) and argues that Kelly teaches the limitation of the fulfillment server and the rejection is based on the combination of Gobburru, Young and Kelly.

Applicant needs to point out that claims 1 and 23 were not rejected in either the final or non-final office action under 35 U.S.C. 103(a) as being unpatentable over Gobburu et al (US 6,736,322), in view of Young et al (US Publication No: 2002/0065774) and further in view of Kelly. If this is the case, it is believed that the final office action was defective. Furthermore, it is also believed that the final rejection would have been premature because the Examiner introduced a new ground of rejection and since the claims were not previously amended, the introduction of the new ground could not have been necessitated by the applicant's amendments .

Furthermore, Kelly et al teach a prize redemption system for games. The cited reference lines refer to a game output device 18 (shown in FIG. 1) that may be "speakers, buzzers, alarms, and other devices providing auditory feedback" (see column 7, lines 64-66). In other embodiments a player inserts a card into a suitable output device 18 and the game unit 10 writes the specific prize that was won on the card" (see column 11, lines 24-34). However, these statements in Kelly et al do not teach in any possible way a fulfillment server that receives payment confirmation from a payment server and then transmits a digital good via an authentication server to the communication device where then communication device stores the digital good onto a payment card. Accordingly, it is concluded that the combination of Gobburru, Young and Kelly fails to teach the fulfillment server limitation. Furthermore, there is absolutely no reason or motivation to combine a prize redemption system for a game with a cell phone that stores digital

coupons and with a method for selling physical goods to a customer after receiving orders via the customer's phone.

D. In the office action of October 18, 2007 (non-final office action), the Examiner admitted that "Gobburru does not specifically disclose the limitation of claims 1 and 23 of:
"a fulfillment server adapted to receive said payment confirmation from said payment server and transmit said digital good via said authentication server to said communication device, wherein said communication device stores said digital good onto said payment card"

The Examiner then argued that Young et al however, discloses the above mentioned limitation. See page 3 of the non-final office action. The Examiner further argued that it would have been obvious to combine the two cited documents to arrive to the present invention of claims 1 and 23.

Applicant responded that neither Young et al teach the above mentioned limitation of: storing the digital good onto the payment card , because one cannot store a physical good such as a coat onto a payment card.

In the final office action again a new reference Kelly (US5,816,918) is presented and it is argued that Kelly teaches the above mentioned limitation and that the rejection is based on the combination of Gobburru, Young and Kelly.

The same arguments presented in point C are valid in this case as well.

E. In point 13 of the final office action it is argued that Gobburru et al disclose the limitations of the merchant server, payment and authentication server and communication device. Applicant would like to point out that this contradicts the statements of the non-final office action (see page 3, point 7). Furthermore, the payment server of Gobburru et

al does not receive a digital order from the merchant server and further routes it, as claimed in the present invention. Gobburru teaches that the user logs directly into her e-wallet on the bank's server (see column 18, lines 16-17). Furthermore, Gobburru teaches that the user's phone stores the user's authentication account. In other words, there is no separate authentication server in Gobburru et al.

F. In point 14 of the final office action it is argued that Gobburru, Young, Jacobson and Kelly teach various individual components of claims 1 and 23. However, there is still no teaching, suggestion or motivation in any of the above mentioned references for combining these individual components as claimed in claims 1 and 23.

Based on the above mentioned reasons the present invention of claims 1 and 23 are patentably distinguishable from Young et al alone or Gobburu et al alone or their combination and from their combination with either Jacobson et al and or Kelly et al.

Claims 2-22 and 24-45 depend upon claims 1 and 23, respectively, since claims 1 and 23 are patentably different from Young et al and/or Gobburu et al they are also patentably different from Young et al and/or Gobburu et al.

G. The Examiner further rejected dependent claims 12, 14, 20, 35, 37 and 43 under 35 U.S.C. 103(a) as being unpatentable over Gobburu et al (US 6,736,322), in view of Young et al (US Publication No: 2002/0065774) and in further view of Jacobson (Us Publication No: 2003/0004876).

Applicant responded that Jacobson paragraph (0015) does not disclose that the "wireless communication device comprises a subscriber identification module (SIM) card slot and that the payment card module is electrically connected to the SIM card slot." , as claimed in claims 14 and 37 of the present invention. Jacobson describes a prior art electronic device capable of accommodating a multimedia card (MMC) and a SIM card. The rear housing portion includes a dual card reader and a recess for accommodating a battery pack. The dual card reader includes a reader housing and a drawer. For electrically

connecting the MMC and the SIM with the electronic device the user places the MMC and the SIM in the drawer, inserts the drawer in the recess and slides the drawer in the reader housing. Since the recess is a battery pack recess and not a SIM card slot the cited prior art reference does not read on claims 14 and 37.

H. It was argued in several points of the final office action that "one cannot show nonobviousness by attacking references individually". However, Applicant referred in both the previous response and the present response to the combination of the cited references and showed that the present invention is patentably different from Young et al and/or Gobburu et al.

I. In the advisory action it was stated that "Applicant contends that claims 1 and 23 were not addressed in either office action" With all due respect, this is a misrepresentation of the Applicants arguments.

It is believed that all of the pending claims have been addressed in this paper. Failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. Nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

In view of the above, it is submitted that all rejections of claims 1-45 are overcome and all claims 1-45 are in condition for allowance. Reconsideration of the claims rejection is requested and allowance of all claims at an early date is solicited.

If this response is found to be incomplete, or if a telephone conference would otherwise be helpful, please call the undersigned at 781-235-4407.

Respectfully submitted,

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I hereby certify under 37 CFR 1.10 that this correspondence is being electronically submitted on the date indicated above and is addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450